

REMARKS

In the Office Action, claim 12 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, insufficient antecedent basis for “the particle size distribution” limitation is asserted. Additionally, the term “lower than about 15% by numbers” is considered unclear. This rejection is respectfully traversed.

Applicants respectfully point out that the quoted phrase (i.e, “the particle size distribution”) does not, in fact, reference an earlier claim recitation or limitation, but is instead part of a term of art (e.g., “the relative standard deviation of the particle size distribution”). See discussion at page 3, lines 19-25 of the present specification. If the scope of a claim would be reasonably ascertainable to one skilled in the art, then the claim is not indefinite. See MPEP §2173.05(c), citing *Ex parte Porter*, 25 USPQ 2nd 1144, 1145 (Bd. Pat. App. & Inter. 1992).

With regard to the phrase “lower than about 15% by numbers”, Applicants again refer to the discussion in the present specification at page 3, lines 20-22 wherein it is stated that “[t]he relative standard deviation of the particle size distribution is the ratio between the mean particle size by numbers and the standard deviation of the particle size distribution”. More particularly, “by number” indicates the ratio calculated on each particle size and not, e.g. an average calculated on the weight of all particles, which would result in a different range. This would also be clear and reasonably ascertainable to one skilled in the art. Applicants further note that the term “about” has been held to be clear. See MPEP §2173.05(b).

Also in the Office Action, claims 1, 6, 8 and 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,102,400 (Crinkelmeyer). This rejection is also respectfully traversed.

Crinkelmeyer is silent with regard to the injection of colloidal silica particles in combination with silicate and a gelling agent in the ration. In fact, Crinkelmeyer is completely silent with regard to the use of colloidal silica particles. The only mentioning of silica in the portions of the Crinkelmeyer specification cited in the Office Action is an example (see col. 7, line 17) wherein silica, not colloidal silica particles, is used as a component to prepare a spacer fluid, not injection of a grouting composition in a leaking part or cavity, in combination with, *inter alia*, sodium metal silicate, not an alkali metal silicate. Thus, Crinkelmeyer does not disclose all of the features of claim 1 and does not anticipate claim 1 nor its dependent claims 6, 8, 10 and 14.

Claims 1, 4, 8, 10, 12 and 14 stand rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,370,478 (Bartlett), or in the alternative, under 35 U.S.C. 103(a) as obvious over Bartlett. This rejection is also respectfully traversed.

Bartlett does not teach, suggest or disclose the combined use of silicate, colloidal silica particles and a gelling agent in the claimed silica:silicate ratio. More specifically, Applicants note that Al or Fe salts, alkali metal silicates, and silica sols are only listed in Bartlett as alternatives, and are not taught in combination. See, for example, the abstract (e.g., "containing water-soluble Al or Fe salts, alkali metal silicates, or silica sols") and col. 5, lines 12-19. In fact, none of these components are even necessary components in a grout material selected for use in the process of Bartlett (see, for example, claims 1 and 12 which do not even mention any of the components as essential technical features of the invention), as it is only necessary for the grout material to have the proper viscosity, density and gelling time for use in the Bartlett invention.

Further, the allegation in the office action that silicate is inherently formed upon reaction of colloidal silica particles with NaCl is incorrect and is also not substantiated in the Office Action. Inherency must be a necessary conclusion from the prior art, not simply a possible one. See *In re Oelrich*, 666 F.2d. 578,

581, 212 USPQ 323, 326 (C.C.P.A. 1981). It is unclear what factual and technical grounds the Office Action is using to assert that silicate is necessarily being inherently formed in the claimed ratios of silica to silicate in Examples 1 and 2 of Bartlett.

Thus, there is no incentive for a skilled person, based on the teachings of Bartlett, to modify the teachings of Bartlett in order to arrive at the presently claimed invention.

Reconsideration of the rejected claims is respectfully requested.

Respectfully submitted,
GREENWOOD, et al.



Michelle J. Burke
Attorney for Applicants
Registration No.: 37,791

Akzo Nobel Inc.
Intellectual Property Dept.
7 Livingstone Avenue
Dobbs Ferry, NY 10522-3408
(914) 674-5459